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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/855,061 05/13/97 AUGUSTINE

S 1342-160C

QM12/0911

TERRANCE A MEADOR
GRAY CARY WARE & FREIDENRICH
401 B STREET SUITE 1700
SAN DIEGO CA 92101

EXAMINER

GRAHAM, M

ART UNIT

PAPER NUMBER

3711

33

DATE MAILED:

09/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/855,061

Applicant(s)

Augustine et al.

Examiner

Mark S. Graham

Group Art Unit

3711



☒ Responsive to communication(s) filed on Jun 19, 2000.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 20-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-23 and 25-39 is/are rejected.

☒ Claim(s) 24 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3304

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 22, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Roehr for the reasons set forth in the previous action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 25, 26, 27, 28, 29, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roehr for the reasons set forth in the previous action.

Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustine '188 in view of Roehr for the reasons set forth in the previous action and above.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roehr in view of Hardy for the reasons set forth in the previous action rejection based on Roehr in view of Hardy and above.

In response to applicant's argument regarding the inflatability of Roehr's device attention is directed to the 6/23/98 office action where this argument has been addressed. Applicant is

11/24/98, 084

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reminded that the size of the apertures and the degree of pressure have not been claimed. All that the claims require is a structure capable of being inflated.

Concerning the non-inflatable portion, applicant's emphasis on the cover thickness is not understood. Fig. 1 clearly shows the location of the weld 15 and the non-inflatable portion beyond this point.

Applicant's next argument is non-sensical. The examiner's position regarding the location of the fabric layer in Roehr is consistent. Whether stated as located where it touch^{es} the patient or stated on the outside of the foil where it will not interfere with the plastic welds the location is the same. The only confusion appears to be on the part of the applicant. If such confusion remains the applicant is urged to contact the examiner for clarification.

In response to applicant's request to back up his assertion on such laminated structures, Moore et al. has been cited to back up the examiner's position regarding the meaning of lined laminated plastic foil structures as known in the art. Additionally Moore indicates that both fabric and paper have been used in the art to back up the examiner's contention that the use of paper as the fibrous material would have been obvious.

In response to applicant's arguments concerning the Roehr/Augustine combination that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the

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art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the greater degree of comfort that a fibrous layer provides for a patient is knowledge generally available to one of ordinary skill in the art. It should also be remembered that the reason to combine need not be the applicant's reason for combining.

Applicant's arguments concerning the tubular structure of Augustine are not understood. Is the applicant asserting that Augustine does not disclose an inflatable device?

Regarding the applicant's arguments concerning the Roehr/Hardy combination it is first noted that Hardy's device is clearly inflatable. However, this is not the point of the rejection. Hardy has been cited to show that it is known in the art to provide a recess in the blanket head portion. Such a recess is by definition non-inflatable. It would have been obvious to have provided such a recess in Roehr's blanket as well to accommodate the head. Regarding the reason to combine note the examiner's above comments concerning the combination of references.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustine in view of Roehr and Hardy for the reasons set forth in the above applications of Roehr and Hardy.

Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed 6/19/00 have been fully considered but they are not persuasive.

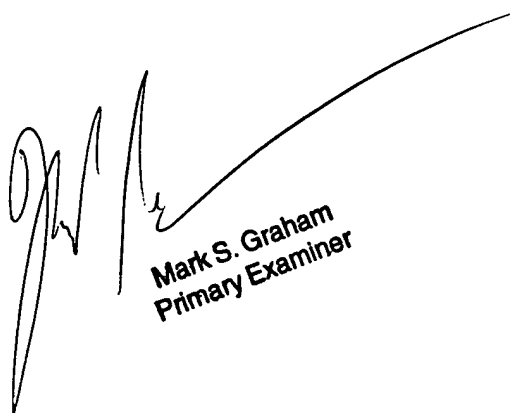
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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG
September 1, 2000



Mark S. Graham
Primary Examiner